

REMARKS

Applicant appreciates the thorough examination of the present application as evidenced by the Final Official Action of March 23, 2005 (hereinafter "Final Action"). Applicant provides the present amendment accompanying a Request for Continued Examination (RCE) to respond to the Final Action and to add new Independent Claims 33-38 in order to further prosecution. In particular, Claim 33 contains recitations corresponding to pending Claims 1-5, Claim 34 contains recitations corresponding to pending Claims 1, 6, 7, 9, and 10, Claim 35 contains recitations corresponding to pending Claims 11, 12, and 14-16, Claim 36 contains recitations corresponding to pending Claims 11, 18, 19, 21, and 22, Claim 37 contains recitations corresponding to pending Claims 23-27, and Claim 38 contains recitations corresponding to pending Claims 23, 28, 29, 31, and 32. No new matter has been added.

Applicant also maintains that Claims 1-32 are patentable for the reasons discussed in Applicant's response of August 4, 2004, which is incorporated by reference herein. Rather than repeating those arguments, Applicant will address the comments of the Examiner in the Response to Arguments portion of the Final Action. Applicant further submits that new Claims 33-38 are patentable for the reasons that will be discussed below.

Response to Arguments

Claims 1-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,740,549 to Reilly et al. ("Reilly") in view of United States Patent No. 6,324,519 to Eldering ("Eldering").

Independent Claim 1 recites, in part:

1. A method for subscriber based generation of a customized publication comprising the steps of:

generating a subscriber list including identifications of a plurality of subscribers for the publication;

providing, to a content provider, at least a portion of the subscriber list including identifications of a first of the subscribers and a second of the subscribers different from the first subscriber...

generating a first version of the publication including the first selected

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content for the first subscriber; and
generating a second version of the publication including the second selected content for the second subscriber. (*Emphasis added*).

In rejecting Claim 1, the Final Action asserts that Reilly discloses providing at least a portion of the subscriber list to a content provider. In support for this assertion, the Final Action states that "[s]ince Reilly has an information server *whose function is providing data or information to users*, the information server is considered equivalent to a content provider. See Final Action, Page 16. However, Applicant submits that, even if the information server is considered a content provider as asserted by the Final Action, Reilly does not disclose providing the subscriber list to any other entity.

More specifically, Reilly describes an information server "which lists all subscribers authorized to receive news items and advertisements from the server". See Reilly, Col. 16, lines 48-52. The list of subscribers is used by the information server to determine if a computer that attempts to connect with the server is in fact an authorized subscriber. As such, the subscriber list is maintained by the information server for its own use, and does not appear to be provided to anything. Thus, Applicant respectfully submits that Reilly does not appear to disclose or suggest "providing, to a content provider, at least a portion of the subscriber list", as recited by Claim 1.

The Final Action further asserts that Eldering discloses different versions of a publication for different subscribers. However, Applicant submits that Eldering describes a system where advertisers can bid to have their printed material included in a single publication that is delivered to multiple subscribers. As recited by Eldering:

Knowing that they will deliver a newspaper or other periodical to consumer 100, they [the content provider] announce an advertisement opportunity to the advertising community. Advertisers respond with ad characterization information, and upon receiving correlation results, place bids to have their printed material inserted into the periodical. The content/opportunity provider selects a bid and upon receiving the advertisement, prints the ad, inserts it into the periodical, and delivers it to the subscriber. (*Emphasis added*).

See Eldering, Col. 11, line 67 to Col. 12, line 8.

Thus, Eldering appears to disclose a publication containing targeted advertisements

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based on the profile information of subscribers of the publication. As such, Eldering does not appear to disclose separate versions of a publication for first and second subscribers. The Final Action argues that "[s]ince each consumer, equivalent to a subscriber, has a specific profile, there *must* be different versions of advertisements for different subscribers." See Final Action, Page 17. (*Emphasis added*). As such, the Final Action concedes that Eldering does not explicitly disclose these recitations. Accordingly, if the Examiner wishes to maintain the above rejection based on Eldering, Applicant respectfully requests that the Examiner cite specific portions of Eldering that disclose "generating a first version of the publication...for the first subscriber" and "generating a second version of the publication...for the second subscriber" as recited in Claim 1.

For at least the above reasons, Applicant submits that Claim 1 and the claims dependent therefrom are patentable over the combination of Reilly and Eldering. Claims 11, 13 and 23 include recitations corresponding to those discussed with reference to Claim 1. As such, Claims 11, 13, and 23 and the claims dependent therefrom are also patentable for at least substantially the same reasons.

New Claims 33, 35, and 37 Are Patentable Over the Cited References

Applicant submits that new independent Claims 33, 35, and 37 are patentable over the combination of United States Patent No. 5,740,549 to Reilly et al. ("Reilly") and United States Patent No. 6,324,519 to Eldering ("Eldering"). Independent Claim 33 recites:

33. A method for subscriber based generation of a customized publication comprising the steps of:
- generating a subscriber list including identifications of a plurality of subscribers for the publication;
 - providing, to an advertiser, at least a portion of the subscriber list including identifications of a first of the subscribers and a second of the subscribers different from the first subscriber;
 - receiving a designation of a first advertisement based on buying preferences of the first subscriber and a designation of a second advertisement based on buying preferences of the second subscriber from the advertiser;
 - associating the first advertisement with the first subscriber based on the identification of the first subscriber;
 - associating the second advertisement, different from the first advertisement,

with the second subscriber based on the identification of the second subscriber; and then

generating a first version of the publication including the first advertisement in a prescribed field of the publication for the first subscriber;

generating a second version of the publication including the second advertisement in a prescribed field of the publication for the second subscriber; integrating content not designated by the advertiser into the first version of the publication and the second version of the publication;

printing the first version and the second version of the publication; and

distributing the printed first version of the publication to the first subscriber and the printed second version of the publication to the second subscriber.

Applicant respectfully submits that the cited references, either alone or in combination, do not disclose or suggest many of the recitations of Claim 33. For example, Reilly describes interaction between an information server and a client computer/workstation. The server maintains content, such as news items and advertisements, which is transmitted from the server and received at the client computer/workstation. *See* Reilly, Fig. 12. More specifically, as described in Reilly, a "data server stores and updates a database of information items and advertisements." *See* Reilly, Abstract. Reilly further discloses that "[w]orkstations remotely located from the data server each include...a communication interface for receiving at least a subset of the information items and advertisements in the data server's database". *See* Reilly, Abstract. Thus, the client computer described in Reilly receives actual advertisement content from the information server.

In contrast, Claim 33 recites "receiving a **designation of** a first advertisement...and a **designation of** a second advertisement...**from the advertiser**". In other words, a designation of an advertisement (in contrast to the advertisement itself) is received from the advertiser. As an initial matter, applicant submits that Reilly does not even appear to disclose such an advertiser. Moreover, even were the server of Reilly to be construed as an advertiser, nowhere does Reilly appear to disclose or suggest receiving a designation of an advertisement, in lieu of the advertisement content itself, from the server. Accordingly, Applicant submits that Reilly does not appear to disclose or suggest all of the recitations of Claim 33.

Nor does Eldering appear to provide such recitations. Eldering describes a system

where advertisers can bid to have their printed material included in one version of a publication that is delivered to multiple subscribers. As described in Eldering, an "[a]dvertiser 144 maintains an ad server 146 which contains a variety of advertisements". See Eldering, Col. 4, lines 7-8. Eldering further describes that "the advertisement is delivered to the content/opportunity provider who delivers the ad to the consumer." See Eldering, Col. 1, lines 55-56. More specifically, as shown in Fig. 7 of Eldering, an advertisement 750 is transmitted from the advertiser 144 and received at the content/opportunity provider 160. See Eldering, Fig. 7. As such, Eldering discloses that the actual advertisement 750, rather than a designation thereof, is received from the advertiser 144. Thus, Eldering does not appear to disclose or suggest at least "receiving a designation of a first advertisement...and a designation of a second advertisement...from the advertiser", as recited by Claim 33.

Accordingly, neither Reilly nor Eldering disclose or suggest all of the recitations of Claim 33. As such, Applicant submits that independent Claim 33 is patentable over the combination of Reilly and Eldering for at least the reasons described above. Independent Claims 35 and 37 include recitations corresponding to those discussed with reference to Claim 33, and are thus patentable for at least substantially the same reasons.

New Claims 34, 36, and 38 Are Patentable Over the Cited References

Applicant submits that new independent Claims 34, 36, and 38 are also patentable over the combination of Reilly and Eldering. Independent Claim 34 recites:

34. A method for subscriber based generation of a customized publication, the method comprising:
- generating a subscriber list including identifications of a plurality of subscribers for the publication;
 - providing, to an advertising distributor, at least a portion of the subscriber list including identifications of a first of the subscribers and a second of the subscribers different from the first subscriber;
 - receiving the at least a portion of the subscriber list at the advertising distributor;
 - determining if any individually targeted content from the advertising distributor is to be provided based on individual profile information maintained by the advertising distributor for each of the first and second subscribers;
 - identifying a first target advertiser for the first subscriber based on the

- individual profile information for the first subscriber;
- identifying a second target advertiser for the second subscriber based on the individual profile information for the second subscriber;
- obtaining first selected content associated with the identified first target advertiser based on the identification of the first subscriber if any individually targeted content is to be provided in the publication for the first subscriber;
- obtaining second selected content associated with the identified second target advertiser based on the identification of the second subscriber if any individually targeted content is to be provided in the publication for the second subscriber; and
- transmitting the first selected content and the second selected content from the advertising distributor;
- receiving the first selected content and the second selected content from the advertising distributor;
- associating the first selected content with the first subscriber based on the identification of the first subscriber;
- associating the second selected content, different from the first selected content, with the second subscriber based on the identification of the second subscriber; and then
- generating a first version of the publication including the first selected content for the first subscriber; and
- generating a second version of the publication including the second selected content for the second subscriber.

Applicant respectfully submits that the cited references do not disclose or suggest many of the recitations of Claim 34. For example, Claim 34 recites "determining if any individually targeted content from the advertising distributor is to be provided based on **individual profile information maintained by the advertising distributor**".

As discussed above, Reilly is directed to interaction between an information server and a client computer/workstation. In particular, as illustrated in Fig. 12 of Reilly, the client computer/workstation stores user profile information, and transmits the user profile information to the information server. *See* Reilly, Fig. 12. More specifically, as described in Reilly, "[a]t least a subset of the workstations include a profiler for storing subscriber profile data." *See* Reilly, Abstract. As such, the subscriber profile information in Reilly appears to be maintained by the client computer, not by an advertising distributor as recited in Claim 34.

In fact, Reilly does not appear to contain any mention of an advertising distributor. As illustrated in Fig. 11, Reilly discloses a client computer and an information server including a

router **270**, application servers **272**, and data servers **274**. As described in Reilly, "[t]he application server 272 then makes calls to one or more data servers 274 to collect all the information that needs to be sent to the client computer and then sends those items to the client computer". *See* Reilly, Col. 15, lines 1-4. As such, the client computer receives information (such as news items and advertisements) from the information server. However, even were one or more components of the information server of Reilly construed as an advertising distributor, it is the client computer, not the information server, that appears to maintain the user profile information. Thus, Applicant submits that Reilly does not appear to disclose or suggest all of the recitations of Claim 34.

Eldering also does not appear to disclose such recitations. As illustrated in Figure 1A, Eldering discloses a system including a content/opportunity provider **160**, an advertiser **144**, and a profiler **140**, each of which maintains respective servers **162**, **146**, and **130**. *See* Eldering, Fig. 1A. As described by Eldering with reference to Figure 1A, "[p]rofiler **140** maintains a consumer profile server **130** which contains the characterization of consumer **100**." *See* Eldering, Col. 4., lines 11-12. Further, as illustrated in Figure 1B, alternate embodiments of the system of Eldering disclose that the consumer **100** may also be the profiler **140**, such that "[c]onsumer **100** maintains consumer profile server **130**". *See* Eldering, Fig. 1B and Col. 4; lines 55-57. Thus, in the embodiments described by Eldering, the consumer profile server **130** is maintained by the profiler **140** or the consumer **100**. As such, neither embodiment appears to describe an advertising distributor that maintains the consumer profile server **130**. Moreover, even were the content/opportunity provider **160** (which receives the advertisements from the ad server **146** and delivers the ad to the consumer **100**) construed as an advertising distributor, the content/opportunity provider **160** does not maintain the consumer profile server **130** in the embodiments described in Eldering. *See* Eldering, Figs. 1A and 1B. Thus, Eldering also fails to disclose or suggest at least "individual profile information maintained by the advertising distributor", as recited by Claim 34.

Accordingly, as neither Reilly nor Eldering disclose all of the recitations of Claim 34, Applicant submits that independent Claim 34 is patentable over the combination of Reilly and

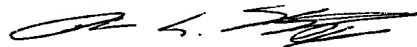
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Eldering for at least the reasons discussed above. Independent Claims 36 and 38 include recitations corresponding to those discussed with reference to Claim 34, and are thus patentable for at least substantially the same reasons.

Conclusion

In view of new Claims 33-38 and the arguments presented both above and in Applicant's response of August 4, 2004, Applicant respectfully submits that the pending claims are patentable over the cited references. Accordingly, Applicant respectfully requests allowance of all the pending claims and passing this application to issue.

Respectfully submitted,



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